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PATENT

Attorney Docket No.: 109846-137

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: DEKKER *et al.*

Art Unit: 1638

Appl. No.: 09/469,812

Examiner: Kruse, D.

Filed: December 22, 1999

For: PLASMIDS FOR PLANT  
TRANSFORMATION AND  
METHOD OF USING THE SAME

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to Examiner Woodward at the United States Patent and Trademark Office, Commissioner for Patents, at fax number 703-746-5278.

August 28, 2001  
Date of Transmission

Laura Lohr  
Name of Person

Commissioner for Patents  
Washington, D.C. 20231  
BOX PETITION

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**PETITION FOR SUSPENSION OF THE RULES**  
**UNDER 37 C.F.R. § 1.183**

Sir:

Applicants petition the Commissioner for a Suspension of the Rules relating to a non-statutory one month time limit for providing a response to an issue raised in the Office Action dated March 28, 2001 (File Wrapper Paper Number 12) (Exhibit 1) for the captioned matter.

Section 1, page 2, of the March 28, 2001 Office Action identifies an allowable claim for the purpose of an Interference. The Office Action further indicates that the suggested claim should be submitted within one month or 30 days from the mailing date

PATENT

Attorney Docket No.: 109846-137

of the Office Action. Failure to make the submission is considered a disclaimer of the subject matter (37 C.F.R. § 1.605(a)). Additionally, the provisions of 37 C.F.R. § 1.136(a) relating to extensions of time for response are not applicable in the present situation.

Applicants believe that the one month response time requirement (hereinafter "the One Month Requirement") should be withdrawn for the following reasons, each one in the alternative being a sufficient basis for withdrawal:

1. The One Month Requirement Placed An Unnecessary Burden On Applicants

Applicants believe that the one month requirement for the submission of the claim unnecessarily burdened Applicants, since a claim pending in the Application is directed to substantially the same subject matter.

Applicants provide as Exhibit Two a copy of the claims pending in the captioned application. Applicants aver that claim 8, drawn to a method for the production of a transgenic plant, is substantially the same as the claim suggested in the outstanding Office Action, which is:

- Proposed Claim 1: A method for producing a transgenic plant containing a polynucleotide of interest, the method comprising:
- (a) introducing into a plurality of plant cells a T-DNA vector comprising:
    - (i) a T-DNA sequence comprising a right border, a left border and the polynucleotide of interest positioned between the right and left border, and
    - (ii) a non-T-DNA sequence comprising a barnase polynucleotide sequence encoding a barnase enzyme, wherein said non-T-DNA sequence is located beyond the left T-DNA border;
  - (b) selecting a plant cell which comprises the T-DNA sequence and does not comprise the barnase polynucleotide sequence; and
  - (c) regenerating a transgenic plant from the selected plant.

More particularly, method claim 8 is a multiple dependent claim utilizing for plant cell transformation any one of the vectors of claims 1-7. As such, the incorporation of vector claim 2 into method claim 8 provides for a method for the

PATENT

Attorney Docket No.: 109846-137

production of a transgenic plant that is substantially similar to the process claim suggested in the outstanding Office Action. Both claims include the production of a transgenic plant comprising the introduction into a plant cell of a T-DNA vector comprising (1) a gene of interest; (2) a right and left border T-DNA sequence on each end of the gene of interest; and (3) a non-T-DNA sequence encoding an RNase molecule (e.g., Barnase).

Applicants, therefore, respectfully request withdrawal of the One Month Requirement on the basis that the requirement was unnecessary for the reasons stated *supra*.

2. The One Month Requirement Was Hidden In The Office Action

Applicants note that time restraints for response to an Office Action are normally ascertained by identifying the mailing date of the document and examining requirements detailed on the first page. Applicants assert that in the March 28, 2001 Office Action, a proper notice of the One Month Requirement was not provided to Applicants.

Applicants hold that the One Month Requirement was an unusually short time restriction to place on Applicants, and as such, fairness to Applicants required that the time period for response be easily and readily identifiable by Applicants.

Notice of the One Month Requirement did not occur until the second page of the Office Action, the beginning of the substantive section of the document. Thus, Applicants believe that the time restraint for Applicants' response was effectively "buried" or "hidden" in the outstanding Office Action.

Accordingly, because Applicants did not receive proper notice of the unusual One Month Requirement, Applicants respectfully request that this requirement be withdrawn.

PATENT

Attorney Docket No.: 109846-137

3. Disadvantage Created By A Change In Representation Before The U.S. Patent and Trademark Office

Applicants were disadvantaged in making a timely response to the One Month Requirement by a change in representation before the U.S. Patent and Trademark Office during the critical time period in question.

Applicants respectfully request that the Commissioner favorably consider this Petition in view of Applicants' misfortune of having the contemporaneous occurrence of a change in representation, with all of the normal complications associated therewith, such as the transfer of files, etc., with the unusual and extremely short response period of the One Month Requirement.

CONCLUSION

Applicants believe that sufficient bases for the granting of this Petition have been provided in the statements provided herein. Under these circumstances, Applicants aver that surrendering of the subject matter of the suggested claim for interference purposes due to a lack of a timely filed response under the circumstances described above is not fair and proper.


Applicants respectfully request favorable consideration of this Petition and the opportunity to be fully responsive to the March 28, 2001 Office Action.

Respectfully submitted,

HALE AND DORR L.L.P.

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